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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/530,147

10/14/2005

Werner Fuchs

P05,0083

1033

26574

7590

10/24/2008

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EXAMINER

PHAM, ANDY L

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

10/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/530,147	<b>Applicant(s)</b> FUCHS ET AL.	
	<b>Examiner</b> ANDY L. PHAM	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-51 and 57-59 is/are pending in the application.
- 4a) Of the above claim(s) 33,35,36,39-51 and 57-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32,34,37,38 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/1/2005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group III, directed to claims 32, 34, 37, 38, and 57 in the reply filed on 07/07/2008 is acknowledged. The traversal is on the ground(s) that since the generic linking claim 32 and the generic linking claim 57 are allowable and inventive over Gnuechtel combined with Keel, the examiner should withdraw the restriction requirement. This is not found persuasive because generic linking claims 32 and 57 are not held to be allowable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.

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- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

2. Claim 34 is objected to because of the following informalities:

In line 2, "a second axis of rotation" will be interpreted to mean "the second axis of rotation." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 32, 34, 37, 38, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gnuechtel et al. (EP 0 367 368 A1) in view of Keel (US 6,676,066).

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6. Regarding claims 32 and 57, Gnuechtel et al. teach a device and method for guiding an endless web, comprising:

a first positionable roll (**44**) which guides the endless web (**40**) directly to an additional positionable roll (**32**) with a predetermined wrap angle on each positionable roll, shafts of said positionable rolls lying parallel to one another in a plane and being held by a frame (**See Figure 3A**);

the web being fed to and led away from the positionable rolls via a respective first stationary roll (**42**) and a respective additional stationary roll (**34**); and

the frame being pivotable relative to the stationary rolls about a first axis of rotation which is substantially perpendicular to said plane in order to modify a position of an edge of the web (**See Figures 2 and 3A**).

However, Gnuechtel et al. lack the frame being pivotable relative to the stationary rolls about a second axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls.

Keel teaches a frame being pivotable relative to the stationary rolls about an axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls (**See Figures 2b and 2c**).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a frame pivotable relative to the stationary rolls about an axis of rotation parallel to a movement direction of the web between the first and additional positionable rolls as taught by Keel for the purpose of maintaining uniform tension on the web as well as to modify a position of the edge of the web.

The functional recitation that the rotation about the first axis combined with the rotation about the second axis prevents sagging of said edge has not been given patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Further, it has been held that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not to amount to the mere claiming of a use of a particular structure. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961).

7. Regarding claim 34, Gnuechtel et al., as modified by Keel teach in which the frame is displaceable in the second axis of rotation with aid of an adjustment device that is actuated by at least one of the functions selected from the group consisting of manually, electrically, hydraulically, and pneumatically. The adjustment device (steering mechanism) in Gnuechtel et al. uses electrical signals from edge sensors in order to adjust the position of the web (Col 6, lines 38-58).

8. Regarding claim 37, Gnuechtel et al. teach in which along the web there is situated at least one sensor (**82**) whose signal is dependent on a sagging of one side of the web (See Col 6, lines 11-52).

9. Regarding claim 38, Gnuechtel et al. teach in which a sensor is situated in a vicinity of the frame at both sides of the web (**82 and 84**; See Col 6, lines 38-52 and **Figure 4A**).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDY L. PHAM whose telephone number is (571)270-1877. The examiner can normally be reached on Monday-Friday 7:30-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on (571) 272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALP

/Ren L Yan/  
Primary Examiner, Art Unit 2854